Remarks:

Applicant has studied the Office Action dated March 27, 2003. Claims 4-6 are rejected under section 102(e) as anticipated by US Patent No. 6,160,778 (the Ito reference). Claims 1-3 and 7-11 are rejected under section 103(a) as obvious over the Ito reference. Particularly, col. 10, lines 35-56 and col. 12, lines 41-67 to col. 13, lines 1-52; Figs. 4 and 5 are cited as anticipating the claimed invention or rendering the invention obvious in light of common knowledge available to one of ordinary skill in the art, at the time of the invention.

It is respectfully submitted that based on our review of the cited sections of the Ito reference, we find at least the following 3 claimed aspects of the invention are neither anticipate nor are obvious because the referenced sections neither individually nor in combination disclose these 3 elements:

> (1) "determining a slipping replacement error in response to the number of PDL registrations,"
>
> (2) "checking a number of un-slipped PDL registrations;" and
>
> (3) "adjusting the recording capacity of the recording medium by the number of un-slipped PDL registrations if the slipping replacement error has occurred."

Particularly, one of the purposes of the present invention is to overcome the shortcomings of the prior art systems that result in a recording medium being rendered useless after a space management routine is performed. Prior art systems, including the Ito reference, teach a space management method that requires replacing defective areas on a recording medium, such as a CD, with designated "spare areas." Unfortunately, this space management method is successful only if the designated spare area is sufficiently large (i.e., at least as big as the sum of all defective areas) to accommodate the required replacement. If the spare area is too small, then an error occurs as the prior art systems attempt to replace the defective areas with other areas of the disk that are not within the designated spare areas.

The Ito reference discloses a method of temporarily handling the above-mentioned problem (i.e., insufficiency of designated spare area) by designating a secondary spare area when the first spare area is fully depleted. The Ito reference, however, fails to anticipate the outcome when the secondary spare area is also depleted. Even based on the teachings of the Ito reference, a crash is unavoidable, when the system attempts to replace a defective area with an area beyond the limits anticipated by the secondary spare area.

The claimed invention provides a solution to the above problem by anticipating the eventual outcome of continuously replacing defective areas with designated spare areas. As claimed, the system before each replacement (1) determines if the spare area is sufficiently large to accommodate the defective sectors by comparing the size of the two areas and (2) adjusting the recording capacity

accordingly. The adjustment, as claimed, is based on the number of defective areas (i.e., un-slipped PDL registrations) for which a replacement cannot be found in the spare area. The Ho reference fails to disclose the above two steps.

A claim is anticipated under 35 U.S.C. § 102 when a single prior art reference expressly or inherently discloses each and every element of the claim in question. Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985). Since the Ito reference fails to disclose at least one of the above recited elements in claim 1, a rejection under § 102 would be improper.

If the Examiner maintains a rejected under 35 U.S.C. § 103(a) based on the combination of the Ito reference and common knowledge, then the Examiner is requested to cite a reference or alternatively provide an affidavit in support of his rejection as required under MPEP §2144.03.[1]

It is well settled that there must be some motivation or suggestion to combine, in the prior art references themselves, to come up with the claimed invention. That is, prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining the teachings." In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983). It is respectfully submitted that nothing stated in the Ito reference teaches, discloses, or suggests (1) "determining a slipping replacement error in response to the number of PDL registrations," (2) "checking a number of un-slipped PDL registrations;" and (3) "adjusting the recording capacity of the recording medium by the number of un-slipped PDL registrations if the slipping replacement error has occurred."

For the above reasons, the invention as recited in the amended claim 1 is distinguishable over the references cited by the Examiner and should be therefore allowed. Independent claims 4 and 7 incorporate the discussed limitations of claim 1 and therefore claims 4 and 7 should be in condition for allowance, as well. Claims 2-3, 5-6 and 8-11 are respectively dependent on claims 1, 4 and 7 and therefore should also be in condition for allowance, by the virtue of their dependency.

No argument made was related to the statutory requirements of patentability unless expressly stated herein; and no argument made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such argument was made to distinguish over a particular reference or combination of references.

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1 "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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